

**TRANSMITTAL OF APPEAL BRIEF (Large Entity)**Docket No.  
ITL.0134P2USIn Re Application Of: **Dennis M. O'Connor, et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/223,516	December 30, 1998	Huy Thanh Nguyen	21906	2621	1486

Invention: **Transmitting Signals to Cause Replays to Be Recorded at a Plurality of Receivers (Amended)****COMMISSIONER FOR PATENTS:**

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

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SignatureDated: **August 6, 2007**

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Typed or Printed Name of Person Mailing Correspondence

CC:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:	§	
Dennis M. O'Connor, et al.	§	Art Unit: 2621
	§	
Serial No.: 09/223,516	§	Examiner: Huy Thanh Nguyen
	§	
Filed: December 30, 1998	§	Atty Docket: ITL.0134P2US
	§	(P4575X2)
For: Transmitting Signals to Cause	§	
Replays to Be Recorded at a	§	Assignee: Intel Corporation
Plurality of Receivers (Amended)	§	

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**APPEAL BRIEF**

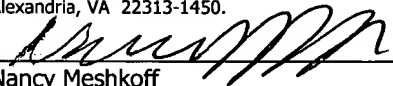
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Nancy Meshkoff

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### **REAL PARTY IN INTEREST**

The real party in interest is the assignee Intel Corporation.

### **RELATED APPEALS AND INTERFERENCES**

- Appeal No. 2000-1762, in Application No. 08/996,535 (now U.S. Patent No. 6,480,667), the grandparent of the subject application.
- Appeal No. 2003-1753, in Application No. 09/150,577 (now abandoned), a continuation-in-part of the '535 (grandparent) application and the parent of the subject application. (The subject application is a continuation-in-part.)
- Pending appeal, Appeal Brief filed on July 24, 2007 in Application No. 11/174,906, also a continuation-in-part of the '535 (grandparent) application.

### **STATUS OF CLAIMS**

Claims 1-44 (Canceled).

Claims 45-47 (Rejected).

Claim 48 (Canceled).

Claims 49-50 (Rejected).

Claims 45-47 and 49-50 are rejected and are the subject of this Appeal Brief.

## **STATUS OF AMENDMENTS**

All amendments have been entered.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

In the following discussion, the independent claims are read on one of many possible embodiments without limiting the claims:

45. A receiver comprising:
- a first device (Figure 10, 1015) to receive a broadcast television program (specification at page 14, lines 4-7);
  - a second device (Figure 10, 1002) coupled to said first device to detect a characteristic of said program (specification at page 25, line 22-page 6, line 15, page 27, lines 16-22);
  - a third device (Figure 10, 1018) to store a replay of a portion of said program in response to the detection of said characteristic (specification at page 14, lines 12-13, page 27, lines 22-24); and
  - a fourth device (Figure 10, 1002) to automatically concatenate a series of recorded replays for automatic sequential playback (specification at page 25, lines 5-7).

At this point, no issue has been raised that would suggest that the words in the claims have any meaning other than their ordinary meanings. Nothing in this section should be taken as an indication that any claim term has a meaning other than its ordinary meaning.



**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

- A. Whether claims 45 and 47 are anticipated under 35 U.S.C. § 102(b) by Hibi (US 5,546,191).**
- B. Whether claims 45-46 and 49-50 are unpatentable under 35 U.S.C. § 103(a) over Heo (DE 19737889) in view of Lee (US 6,310,839).**
- C. Whether claims 45-47 and 49-50 are unpatentable under 35 U.S.C. § 103(a) over Nielsen (US 5,778,137) in view of Taira (US 5,636,200).**

## ARGUMENT

**A. Are claims 45 and 47 anticipated under 35 U.S.C. § 102(b) by Hibi (US 5,546,191)?**

In the final rejection, the following assertions are made at page 3, first full paragraph:

1. It is noted that Hibi teaches that the replays are automatically concatenated since the replays are arranged into a list of sequential playback.
2. Hibi teaches the replays are automatically captured and arranged in a time sequence as a list.
3. Figure 16 shows a display of recorded replays arranged into a list of sequential replays for playback in a time base to enable a user to select or to automatic selection playback.
4. Upon the user selects a playback, all of the replays will be automatically sequentially played back by the apparatus.

Each of the above-cited assertions are contrary to the reference and completely unsupported by the reference. To the contrary, they amount to nothing more than the unsupported statement that the reference teaches what is claimed.

The only cited support is column 13, lines 1-17, which, like the material previously pointed out in the previous response, shows that the cited reference does the opposite of what is claimed. Namely, in the cited material, it is stated that "one of the small screens is selected by moving the corresponding character with the movable button ...." It is clear that one, and only one, of the small screens is selected. The assertion that the small screens are automatically selected in a sequential basis is totally unsupportable and is contrary to the cited language within the reference. Such a rejection is unsustainable.

Namely, the assertion of sequential playback is totally unsupported. As such, it has no hope of being sustained and should be reconsidered. To the contrary, the reference is explicit that the items are individually selectable and are not automatically played back in sequence. The assertion that just because a series of items are provided, that they would be sequentially played back is baseless. Instead, what happens is one can select whichever of the replays one wishes, but there is no concatenation for automatic playback suggested anywhere within the reference.

Therefore the rejection should be reversed.

**B. Are claims 45-46 and 49-50 unpatentable under 35 U.S.C. § 103(a) over Heo (DE 19737889) in view of Lee (US 6,310,839)?**

Claim 45 is also rejected under Section 103 over the combination of Heo in view Lee. It is noted that Heo fails to teach means for concatenating the recorded replay. For this Lee is cited with reference to Figure 7. A discussion of Figure 7 is contained in column 7, lines 23-34.

Again, as in the case with Hibi, this reference seems to teach away. It talks about highlight numbers that an editor can use to navigate the appropriate portion of the media and "view the candidate clip." Clearly, it is not talking about seeing a sequence of clips, but selecting one of the candidate clips. Nothing suggests automatic sequential replay of a plurality of replays selected by detecting a characteristic of a program.

The office action includes a non-specific reference to columns 3 and 4. Certainly, if this feature was somewhere within that material, it is believed that it could be pointed out with greater specificity. However, this material has been reviewed and no support for the rejection can be found therein.

It is respectfully suggested that the asserted rationale to combine, even if Lee had taught what is claimed, is infected with hindsight reasoning. There is nothing within the references that suggests any reason to modify to do what is claimed. To the contrary, all the cited references suggest selecting one, and only one, of a list of items for playback.

Therefore the rejection should be reversed.

**C. Are claims 45-47 and 49-50 unpatentable under 35 U.S.C. § 103(a) over Nielsen (US 5,778,137) in view of Taira (US 5,636,200)?**

The office action suggests that Nielsen teaches a second device 109 coupled to the first device to detect a characteristic of the program. However, Nielsen describes the device 109 only as a selection device that "determines if the user has set the system into a mode for recordation of highlights. If not, the video stream is passed directly to the display 111 ...." Thus, it does not appear that there is any basis to conclude that the device 109 detects a characteristic of the program. Rather, all it does is determine a user selection.

Whatever mode the user sets the system into has no bearing on what the program is and, therefore, it cannot reasonably be contended that Nielsen teaches a second device to detect a

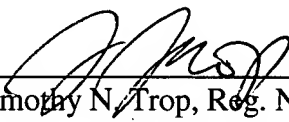
characteristic of the received broadcast television program. Thus, the asserted combination breaks down and the rejection should be reversed.

\* \* \*

Applicant respectfully requests that each of the final rejections be reversed and that the claims subject to this Appeal be allowed to issue.

Respectfully submitted,

Date: August 6, 2007

  
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## **CLAIMS APPENDIX**

The claims on appeal are:

45. A receiver comprising:
  - a first device to receive a broadcast television program;
  - a second device coupled to said first device to detect a characteristic of said program;
  - a third device to store a replay of a portion of said program in response to the detection of said characteristic; and
  - a fourth device to automatically concatenate a series of recorded replays for automatic sequential playback.
46. The receiver of claim 45 wherein said second device to detect a queue encoded with the program.
47. The receiver of claim 45 wherein said receiver is a computer system.
49. The receiver of claim 45 wherein said second device to detect a signal indicating that storage should start and another signal indicating that recording should end.
50. The receiver of claim 45 wherein said first device to receive a signal including a queue to indicate the start of storing by said video recorder.

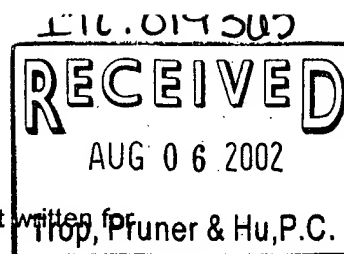
## **EVIDENCE APPENDIX**

None.

## **RELATED PROCEEDINGS APPENDIX**

This appendix includes copies of the following:

- Decision on Appeal No. 2000-1762, in Application No. 08/996,535, the grandparent of the subject application.
- Decision on Appeal No. 2003-1753, in Application No. 09/150,577, a continuation-in-part of the '535 (grandparent) application and the parent of the subject application.



The division in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte DENNIS M. O'CONNOR

Appeal No. 2000-1762  
Application No. 08/996,535

ON BRIEF

MAILED

JUL 31 2002

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before BARRETT, DIXON, and GROSS, Administrative Patent Judges.

DIXON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5-7, 9, 10, and 26-32. Claims 11-15 are allowable and claims 4 and 8 are objected to as dependent upon a rejected claim. In the advisory action, mailed July 2, 1999, the examiner indicated that claims 18, 20, 21, and 24 are allowable.

We AFFIRM-IN-PART.

DOCKET INFORMATION

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Due Date: 8.31-02

Action: Request for Reconsideration  
9-29-02 Appeal to Court of Appeals

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## BACKGROUND

The appellant's invention relates to a method of time shifting to simultaneously record and play a data stream. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of displaying a video stream comprising the steps of:
  - (a) receiving a video stream at an input;
  - (b) recording the video stream to a random access storage unit;
  - (c) retrieving a portion of the video stream from the storage unit while continuing to record the video stream in the step (b); and
  - (d) providing at an output the portion of the video stream retrieved in the step (c).

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Sata et al. (Sata)	5,134,499	Jul. 28, 1992
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Claims 1, 2, 5-7, 9, 10, and 26-32 stand rejected under 35 U.S.C. § 102 as being anticipated by Sata.<sup>1</sup>

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the

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<sup>1</sup> We note that the examiner's answer repeat the same statement of the rejection from the final rejection which rejects claims 18, 20, 21, and 24. We will treat these claims as allowable in view of the advisory action.

examiner's answer (Paper No. 13, mailed Dec. 3, 1999) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 12, filed Oct. 1, 1999) and reply brief (Paper No. 14, filed Feb. 7, 2000) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant elects at page 9 of the brief to group the claims into four groupings. Therefore, we choose claims 1, 6, 26 and 28 as the representative claims for each of the respective groups. Appellant then addresses the claims in reverse numerical order rather than addressing the broadest claim first. We find independent claim 1 to be the broadest claim, and we will address the rejection of claim 1 at the outset.

The examiner maintains that Sata teaches the claimed invention and refers to col. 7 and Figure 1 of Sata. (See answer at page 3.) We will address each of the four steps of claim 1. First, Sata clearly teaches receiving a video stream at an input which may be the television signal, the signal from the tuner or the signal from the FM circuit. Second, this input signal is recorded to a random access memory medium 4 via write head driving circuit 3. Memory medium 4 is disclosed in the abstract and at col. 4 as

an optical disk or a magneto-optical disk. In our view, an optical disk or a magneto-optical disk is a random access memory because it is possible to jump to locations on the disk and it is not necessary to follow the spiral track to get to a certain location as it would be for a serial access memory. Furthermore, the abstract of Sata discloses that "the video information is read from a desirable designated position of the track in the writing direction." From our understanding of the disclosure of Sata, a "desirable designated position" would be something other than a serial accessing of the stored data and, therefore, would be random access storage. This position is further supported by col. 6 of Sata which states that "read designating data and track designating data to be fed to the system controller 22 are both generated when an operator console (not shown) is operated." Third, Sata discloses that it can simultaneously record while reproducing stored video data at col. 7, lines 28-32: "[T]he present embodiment can simultaneously play back and reproduce the previous part of the television program the moment the VTR 8 continuously records the current part of the television program." Additionally, Sata states at col. 7, lines 7-20:

[T]he demodulation circuit 6 can output the continuous video signal. When the video signal from the television tuner 1 is changed over to the video signal outputted from the demodulation circuit 6, the display unit of the television 7 displays the pictures corresponding to the video data, wherein these pictures retroact to the previous time which is prior to the current time by the period corresponding to the designated track position. As described above, by selectively reading out one of the video data recorded on the disk 4 and the video data stored in the RAM 31, it is

possible to watch the previous pictures of maximum 30 minutes the moment the television tuner 1 tunes and outputs the current pictures.

From our understanding of Sata, Sata uses both types of memory for storage to reproduce and output the stored data. Therefore, Sata teaches retrieving from the random access storage while continuing to record the video stream to the random access storage unit/disk. Fourth, by allowing a user to watch the video, Sata teaches providing an output of the portion of the video retrieved. Therefore, we find that Sata teaches the claimed invention.

Appellant argues that "[t]here is no way described in the reference to allow both reading from the RAM 31 and writing to the RAM 31 to occur at the same time." (See brief at page 14.) We disagree with appellant's interpretation of the rejection. The examiner clearly identifies medium 4 as the storage unit. (See answer at page 3.) Therefore, this argument is not persuasive. While appellant identifies that the RAM is only used at different times while the read and write heads are transitioning, appellant does not address the reading and writing from/to the optical disk. (See brief at page 16.) Therefore, this argument is not persuasive. Appellant argues that Sata teaches away from the claimed invention. (See brief at page 16.) We disagree with appellant since Sata teaches the storage and retrieval of video data from a random access memory at the same time. Therefore, we agree with the examiner that Sata teaches

the invention as recited in claim 1, and we will sustain the examiner's rejection of independent claim 1 and dependent claims 2 and 5.

With respect to independent claim 6, Sata teaches at col. 7 in the modified first embodiment that more than one pair of heads can be used to continuously record plural videos. While we find this similar to the claimed invention, we find no discussion that the "one or more stores of step (b) are multiplexed with the one or more reads of step (c)" as recited in the language of claim 6. Appellant argues that there is no teaching of multiplexing in Sata. (See brief at page 14.) We agree with appellant. Therefore, the examiner has not set forth a *prima facie* case of anticipation with respect to independent claim 6, and we will not sustain the rejection of claims 6, 7, 9, and 10.

With respect to independent claim 26, appellant argues that Sata does not teach the playback of "any portion of the stored video information." (See brief at page 12.) Appellant argues that the memory utilized in Sata is a serially accessed memory and that optical memory is conventionally a serial memory. (See brief at pages 12-13.) We disagree with appellant as discussed above. While the data is stored serially, it appears that it need not be accessed serially, but may be accessed from a designated position, thereby being random access to allow any portion of the stored data to be accessed as recited in the language of independent claim 26. Appellant argues that Sata is "completely irrelevant to claims 26 and 28". (See brief at page 13.) We disagree with appellant. Appellant argues that there is no drive for the read head as

indicated in col. 5 of Sata and that "any portion" of the stored data cannot be accessed. (See brief at page 13.) We disagree with appellant. The portion of Sata referenced by appellant refers to the drive motor for rotating the disk and not movement of the read head. Clearly, Figure 2 shows that optical head 21 has a feed motor 23 associated therewith. Therefore, this argument is not persuasive.

Appellant argues that Sata does not provide a sufficient teaching of allowing any portion of the stored data to be accessed and the rejection must fall flat on its face. (See brief at page 14.) We disagree with appellant as discussed above. Therefore, this argument is not persuasive, and we will sustain the rejection of independent claim 26 and dependent claim 27.

With respect to independent claim 28, as mentioned above with independent claim 6, Sata teaches that the system may also continuously record plural videos at col. 7 and in Figure 3 and encompasses plural pairs of read and write heads. Therefore, we find that it is inherent that if plural videos may be recorded continuously, then there must be a selection by an operator to replay a selected video at a designated portion as discussed above with respect to claim 26. Appellant argues that the examiner distorts the teachings of Sata. (See brief at pages 10 and 11.) We disagree with appellant and find that appellant has misinterpreted the rejection, as discussed above.

Appeal No. 2000-1762  
Application No. 08/996,535

Therefore, we find that appellant has not rebutted the examiner's *prima facie* case of anticipation, and we will sustain the rejection of independent claim 28 and dependent claims 29-32.

### CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 5, and 26-32 under 35 U.S.C. § 102 is affirmed, and the decision of the examiner to reject claims 6, 7, 9, and 10 under 35 U.S.C. § 102 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

### AFFIRM-IN-PART



LEE E. BARRETT  
Administrative Patent Judge



JOSEPH L. DIXON  
Administrative Patent Judge



ANITA PELLMAN GROSS  
Administrative Patent Judge

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JD/RWK

Appeal No. 2000-1762  
Application No. 08/996,535

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ITL-0100P145  
P4575X

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

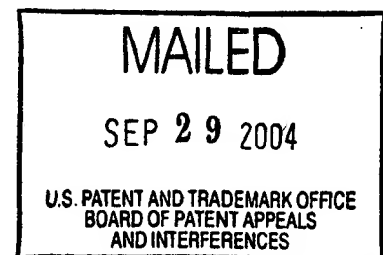
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Trop, Pruner, & Hu, P.C.

*Ex parte* DENNIS M. O'CONNOR and MARK P. CHUANG

Appeal No. 2003-1753  
Application No. 09/150,577

ON BRIEF



Before HAIRSTON, FLEMING, and BARRY, *Administrative Patent Judges*.  
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-5, 11, 13, 14, 16, 17, 20, 21, 23, and 24.  
The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

BACKGROUND

The invention at issue on appeal records and plays back a video stream. A video cassette recorder ("VCR") records a video stream on a video cassette. After recording, the VCR is used to rewind the video cassette and play back what was recorded. (Spec. at 1.)

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a appeal to the Bd. of Appeals

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The appellants observe that once recording commences, however, the part of the video stream already recorded cannot be played back until the recording is finished. Consider a user who knows he will miss the first few minutes of a two-hour television show. He programs a VCR to record the whole show. When the user arrives home, he must wait for the entire show to be recorded before he can start watching it from the beginning. (*Id.*)

In contrast, the appellants' invention allows parts of a video stream to be alternately written to, and read from, a storage device. The next part to be written to the storage is temporarily stored in a buffer while another portion is being read from the storage. (*Id.* at 2.) Because the invention decouples recording and playback, the appellants explain, a user may begin watching a recorded show before it is completely recorded. (*Id.* at 5.)

A further understanding of the invention can be achieved by reading the following claim.

1. A method of allowing a video stream to be displayed and recorded comprising:

allowing a first portion of a video stream to be written to a storage medium while a second portion of a video stream is being read from a storage medium; and

providing a zoom function so that the second portion may be scaled for implementing the zoom function while said first portion of the video stream is being written.

Claims 1-5, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,134,499 ("Sata") and U.S. Patent No. 6,335,730 ("Gould").

Claims 11, 13, 14, 20, 21, 23, and 24 stand rejected under § 103(a) as obvious over Sata; Gould; and U.S. Patent No. 5,432,769 ("Honjo").

#### OPINION

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained." *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7) (2001)). If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *Id.*, 63 USPQ2d at 1465.

Here, the appellants stipulate, "on appeal, claims 2-5, 16, and 17 may be grouped with claim 1; claims 13, 14, and 20 may be grouped with claim 11; and claims 23 and 24 may be grouped with claim 21." (Appeal Br. at 11.) We select claims 1, 11, and 21 from the groups as representative of the claims therein. With this representation in mind, our opinion addresses the claims in the following order:

- claims 1-5, 16, and 17
- claims 11, 13, 14, and 20
- claims 21, 23, and 24.

#### A. CLAIMS 1-5, 16, AND 17

Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween. The examiner finds that Sata "disclose[s] the claimed feature of writing a portion of video stream to a recording medium while another portion of a video stream is being read from the recording medium." (Examiner's Answer at 6-7.) He further finds that Gould "disclose[s] the feature of providing a zoom function to reproduced video data from a recording medium. . . ." (*Id.* at 7.) The examiner concludes, "when the cited reference of Sata is modified in view of Gould's apparatus for . . . incorporating in . . . Sata's reproducing means the capability of applying a zoom function to the reproduced data . . . such a claimed invention . . . would be present in the proposed combination of Sata and Gould." (*Id.*) The appellants argue, "Gould does not teach doing the zoom function on

the second portion while the first portion of the video stream is being written." (Appeal Br. at 12.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious.

#### 1. Claim Construction

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000).

Here, claim 1 recites in pertinent part the following limitations: "allowing a first portion of a video stream to be written to a storage medium while a second portion of a video stream is being read from a storage medium; and providing a zoom function so that the second portion may be scaled for implementing the zoom function while said first portion of the video stream is being written." Giving the representative claim its broadest, reasonable construction, the limitations require writing a first part of a video

stream to a storage medium while a second part of the video stream is being read therefrom in a zoomed format.

## 2. Obviousness Determination

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck*, 800 F.2d, 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). "Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) (quoting *Keller*, 642 F.2d at 425, 208 USPQ at 881).

Here, Sata discloses "a video recording apparatus . . . for recording/reproducing picture information of a television system." Col. 1, ll. 10-12. More specifically, the "apparatus . . . writes video information on a track formed on a recording medium in a writing direction which directs from a predetermined start position to a predetermined end position of track by use of a head. Thereafter, the video information is read from a desirable designated position of the track in the writing direction." Abs., ll. 1-8. The examiner's finding that the video recording apparatus writes a first part of a video stream to a storage medium while a second part of the video stream is being read therefrom is uncontested. Furthermore, the reference supports the finding by disclosing that the apparatus "can simultaneously play back and reproduce the previous part of the television program the moment the VTR 8 continuously records the current part of the television program." Col. 7, ll. 29-33.

Turning to the secondary reference, Gould's invention relates to "tools to improve user perspectives and enhance navigation or browsing of information sources. . . ." Col. 1, ll. 9-11. "FIG. 12 depicts application of the invention to video, for example, with Apple QuickTime video. QuickTime allows a user to play through a video presentation with a window just like playing a video tape on a VCR, except that QuickTime also allows editing of one or more of the frames making up the video." Col. 6, ll. 29-34. The examiner's finding that the invention allows the video to be played back in a zoomed

format is uncontested. Furthermore, the secondary reference supports the finding by disclosing that "not only is the user allowed to select and display the scope of salient segments, but as a further feature allows the user to **vary the degree of magnification** of the salient segments," col. 7, ll. 10-13 (emphasis added), and by describing its "zoom control function," col. 9, l. 60, as an "important aspect[]" of the invention. . . ." *Id.* at l. 53.

Gould's "major benefit[]" is to allow users to quickly navigate through a large information space and to control the salience of the displayed information in the context of the full display while conserving display area, sometime called desktop real estate." Col. 2, ll. 44-48. "Moreover, maintaining a single window for the data and giving users the ability to visually navigate across the whole data via the scroll bar together with the ability to select the salient segments as well as the level of zoom, all in a single step, greatly enhances the ability of the user to cope intelligently and rapidly with large information structures containing large numbers of objects." *Id.* at ll. 48-54.

Because Sata's video recording apparatus writes a first part of a video stream to a storage medium while a second part of the video stream is being read therefrom, and Gould's invention allows video to be played back in a zoomed format to enhance the ability of the user to cope intelligently and rapidly with information, we conclude that the combined teachings of the references would have suggested writing a first part of a



video stream to a storage medium while a second part of the video stream is being read therefrom in a zoomed format. Therefore, we affirm the obviousness rejection of claim 1 and of claims 2-5, 16, and 17, which fall therewith.

#### B. CLAIMS 11, 13, 14, AND 20

The examiner finds, "in Sata's Figure 1, components 3-5, and claim 1 . . . it is disclosed a writing head which can move independently from a reading head, therefore, such a capability of alternating writing while reading video data to and from a storage device would be a present characteristic of Sata et al's apparatus because both heads (writing and reading) as disclosed are independently controlled." (Examiner's Answer at 7-8.) The appellants argue, "in the parent case, the Board determined that multiplexing reads and writes was not shown in Sata." (Appeal Br. at 12.)

#### 1. Claim Construction

"[L]imitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, contrary to the appellants' argument, the limitations of claim 11 do not require multiplexing reads and writes. Instead, the representative claim recites in pertinent part the following

limitations: "allowing portions of the video stream to be alternately written to and read from a storage device. . . ."

## 2. Obviousness Determination

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). After a *prima facie* case of obviousness has been established, the burden of going forward shifts to the applicant. Rebuttal is . . . 'a showing of facts supporting the opposite conclusion'. . . ." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Heldt*, 433 F.2d 808, 811, 167 USPQ 676, 678 (CCPA 1970)).

Here, the examiner has met his burden by offering the aforementioned finding of why "alternating writing while reading video data to and from a storage device would be a present characteristic of Sata et al's apparatus. . . ." (Examiner's Answer at 8.) The appellants fail to address, let alone rebut, the examiner's finding. Therefore, we affirm the obviousness rejection of claim 11 and of claims 13, 14, and 20, which fall therewith.

C. CLAIMS 21, 23, AND 24

The examiner concludes, "the claimed feature of the buffer size being greater or equal to the time it takes to read or write from two buffers to and from the storage device would also be present in the proposed combination of Sata et al and Honjo." (Examiner's Answer at 8.) He explains that the "proposed combination already includes the capability of reading and writing data to and from the two buffers at a time (See the buffers that would have to be incorporated before the recording means and after the reproducing means; and the capability of writing and reading at the same time, since, the heads are independently controlled). Therefore the size of the buffers would necessarily be at least equal to the time it takes to read and write to and from the buffers and to and from the storage device." (*Id.*) The appellants argue, "[i]t is not believed that claim 22 has ever been specifically addressed in any office action to date." (Appeal Br. at 12.)

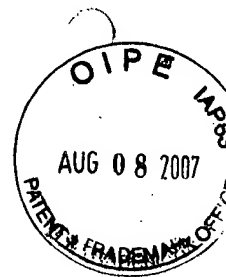
Again, the examiner has met his burden by offering the aforementioned explanation of why "the size of the buffers would necessarily be at least equal to the time it takes to read and write to and from the buffers and to and from the storage device." (Examiner's Answer at 8.) The appellants again fail to address, let alone rebut, the examiner's explanation. Therefore, we affirm the obviousness rejection of claim 21 and of claims 23 and 24, which fall therewith.

### CONCLUSION

In summary, the rejections of claims 1-5, 11, 13, 14, 16, 17, 20, 21, 23, and 24 under § 103(a) are affirmed.

"Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

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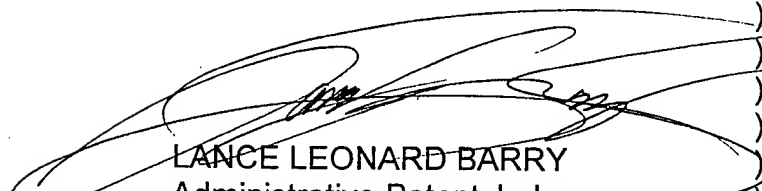


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AFFIRMED

  
KENNETH W. HAIRSTON  
Administrative Patent Judge

  
MICHAEL R. FLEMING  
Administrative Patent Judge

  
LANCE LEONARD BARRY  
Administrative Patent Judge

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